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| NIXON PEABODY LLP       |             |                      | FABER, DAVID        |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |
|------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/727,264 | <b>Applicant(s)</b><br>GORSLINE ET AL. |
|                              | <b>Examiner</b><br>DAVID FABER       | <b>Art Unit</b><br>2178                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 October 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 46-96 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 46-96 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. This office action is in response to the Request for Continued Examination and the Rule 1.131 Affidavit/declaration filed on 23 October 2008.
2. The objection to the specification has been withdrawn as necessitated by the amendment.
3. Claims 46-96 are pending. Claims 46, 63, and 80 are independent claims.

#### ***Affidavit/Declaration under 37 CFR 1.131***

4. The declaration filed on 23 October 2008 under 37 CFR 1.131 has been considered, but is ineffective to overcome the Yasnovsky et al reference.  
Applicant attempts to establish a prior invention prior to July 28, 2003, the effective date of the subject matter of Applicant's invention was conceived before the filing date of Yasnovsky et al.

#### **1) 37 CFR 1.131(a) clearly states**

§ 1.131 Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country.

Applicant fails to disclose in the declaration that the prior invention was established in the United States, a NAFA country or a WTO country. Therefore, the declaration fails to meet the requirements of 37 CFR 1.131.

**2) MPEP 715.04 clearly states**

I. WHO MAY MAKE AFFIDAVIT OR DECLARATION

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims.

Applicant fails to disclose all the inventors of the present invention and have their signatures in the declaration. In addition, Applicant fails to disclose to which inventors of the pending application are or are not inventors of every claim of the application; thus, the declaration is improperly signed. Therefore, the declaration fails to meet the requirements of 37 CFR 1.131.

**3) MPEP 715.07 clearly states**

I. GENERAL REQUIREMENTS

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;

(F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);

(G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. Ex parte Homan, 1905 C.D. 288 (Comm'r Pat. 1905);

(H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception.

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d).

A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

Applicant relies upon the invention disclosure of a printout of Applicant's invention, describing Applicant's invention, that was prepared for internal use within CNET Networks prior to July 28, 2003. The statement in the affidavit "Exhibit A is a true printout of an invention description that was prepared for internal use within CNET Networks, Inc., prior to July 28, 2003. Exhibit A provides descriptions and figures for embodiments of the claimed invention. For example, Figure 2 shows a diagram for automatically generating aggregate creatives corresponding to the concepts described in the present application with reference to FIGS. 4-7."

This is a general allegation that the invention was completed prior to the date of the reference which is non sufficient. The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR

1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (MPEP 715.07)

#### **4) MPEP 715.07(a)Diligence**

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Yasnovsky et al reference to either a constructive reduction to practice or an actual reduction to practice. Applicant stated in the affidavit "Additionally, from prior to July 28, 2003 to at least until December 3, 2003, the filing date of the '264 application, I also continued to diligently investigate and refine as a joint inventor the technology that is the subject matter of the '264 application. In addition to

work on the technology from prior to July 28, 2003 to December 3, 2003, I continued to diligently work with Patent Counsel on developing as a joint inventor the patent application that resulted in the '264 application." However, this statement does not show proper diligence. It is not enough merely to allege that applicant or patent owner had been diligent. Rather, applicant must show evidence of facts establishing diligence. The applicants must account for the entire period during which diligence is required for by either affirmative acts or acceptable excuses, and the work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention. Please refer to MPEP 2138.06

5. For at least the reasons cited above the declaration is ineffective. Therefore the Erickson rejection is maintained.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 63-96 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**For your reference, below is a section from MPEP 2106:**

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se  
Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional

Art Unit: 2178

change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

8. Claims 63-96 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 63-79 disclose a system; however, the claims and fail to disclose if this system indicate any hardware since The use of the word "system" does not inherently mean that claim is directed to a physical machine. Claims 80-96 disclose a storage device; however, the written claim language of the claims fail to disclose if this storage device indicates any hardware therefore the storage device representing a data structure. The claims appear to be claiming "software

systems" i.e. systems without hardware indication, which is a computer program per se. Since the claims disclose computer program per se that is not embodied on a computer readable medium, they appear non-statutory.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 46, 49-55, 58-63, 66-72, 75-80, 83-89, and 92-96 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evan et al (US PGPub 20020036654, published 3/28/2002) in further view of Yasnovsky et al (US PG Pub 20050027594, filed 11/3/2003, provisional application filed on 7/28/2003)

As per independent Claim 46, Evans et al discloses a method comprising:

- receiving an aggregate creative definition, the aggregate creative definition being associated with an aggregate creative that is selectable by an advertising system; (Paragraph 0058; FIG 3, 302-304 - Discloses a number of advertising formats the user is able to choose from. Once the format is selected, the user chooses from a plurality of templates related to the advertising format. (Paragraph 0063))
- selecting, in accordance with the aggregate creative definition, at least one set of subcreatives of more than one subcreative from a plurality of

subcreatives in the advertising system, (Paragraph 0071 discloses the use ad areas on templates, wherein the template (set) include product references (subcreatives) that include an image reference of the product and text reference; wherein the template includes multiple ad areas (or placement for multiple sets) (Paragraph 0069) In addition, product references also include SKU numbers, barcodes, trademarks, logos, etc. These product references are retrievable from one or more databases. (Paragraph 0076-0077)) Furthermore, the user has the ability to create its own product ad contain product references from a database of product references (Paragraph 0066-0068)

- assembling a plurality of aggregate creative forms, each aggregate creative form comprising one or more of the subsets of subcreatives in accordance with the aggregate creative definition; (Each template may contain multiple ad areas (Paragraph 0069) which each ad area able to contain more than one product references (Paragraph 0068, Page 6, lines 5 – 14; Paragraph 0071. Therefore, Paragraph 0088, Paragraph 0095: Discloses one embodiment wherein a template and a list of product references are submitted to a assistance layout program that lays out the product references into the template. Here, the computer would read the list of product references, select the product reference, obtain the product reference and place it into template based on the instructions of either priority based or order-based from the list. Each product being advertised has multiple product references from which

the assistance layout program may choose. Since the program has multiple product references to choose from, it provides greater flexibility creating multiple advertisements. Thus a process of creating a computer-created advertisement, hence using a computer that is used to create ads using an automated assembly. Furthermore, it is implicitly known if the Evans et al's method is capable of performing the functionality once, then it may generate the same functionality over again. Thus multiple computer-created advertisements have the functionality to be generated.)

- storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising system; and when the aggregate creative is selected for transmission to users on an electronic network by the advertising system, selecting one of the plurality of stored aggregate creative forms associated with the aggregate creative, and retrieving the selected aggregate creative form for the transmission. (Paragraph 0091 discloses the user accounts service that provides access to a memory storage device that the user may store data. Thus, a user using an Internet connection may store product references, templates and other custom information such as user's files, and data. In addition, the final advertisements may stored on emails or websites. (Paragraph 0052) Furthermore, the user has the ability to have the advertisement that was just created be transmitted to users via a printer, email or posted on a web site (Paragraphs 0051, 0052, 0092, 0095, Claim 17)

However, Evans et al fails to specifically disclose rotating through the at least one set of more than one subcreative; and selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative. However, Yasnovsky et al discloses of a location on a web page that may contain only three ads at a time (three ad spots for three different adds) out a possible 100 ads to use; wherein the each ad may contain text+link, graphic+link etc. Yasnovsky discloses each time the ads are presented in each of the three ad spots, each ad spot places an ad through in rotation. In other words, each ad spot rotates through a different ad each time. (Paragraph 0035-0036, 0041-0042) Thus for each time the web page is viewed, a different combination of three ads are presented based rotating of 100 ads shown three at a time.

It would have been obvious to one of ordinary skill in the art at the time of Application's invention to have modified Evan's advertisements creation method with Yasnovsky et al's feature of rotating ads since it would have provided the benefit of cost efficiently reach advertisers that want to place only a limited number of ads.

As per dependent claim 49, Claim 49 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 50, Claim 50 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 51, Claim 51 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 52, Claim 52 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 53, Evans et al discloses wherein the plurality of subcreatives includes graphic subcreatives, text subcreatives, (Paragraph 0071, lines 5-8) However, Evan et al fails to specifically disclose hyperlink subcreatives. However, based on the rejection rotating through the at least one set of more than one subcreative; and selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative, by Yasnovsky, and the rationale incorporated, Yasnovsky discloses hyperlink subcreatives. (Paragraph 0041)

As per dependent claim 54, Evans et al discloses the plurality of sets of subcreatives include different numbers of subcreatives. (Paragraph 0066, 0075, 0076)

As per dependent claim 55, Evans et al fails to specifically disclose wherein at least two of the sets of subcreatives share one or more common subcreatives. However, Evans discloses an embodiment of utilize multiple databases of product references wherein one database of references is for advertising nationally, while another database of references is for advertising locally. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention that the same product reference be stored and used nationally and locally since it would provide the benefit of getting advertised at a national scale for more attention, but the same time, advertising a product that has well-known positive feedback in a local area.

As per dependent claim 58, Evans et al fails to specifically disclose the step of tracking transmitted subcreatives transmitted to users on the electronic network. However, based on the rejection rotating through the at least one set of more than one subcreative; and selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative, by Yasnovsky, and the rationale incorporated, Yasnovsky discloses collecting statistical information in regards to advertisements such indicating the number of times ads are displayed, number of clicks, etc. (Paragraph 0052)

As per dependent claim 59, Evans et al discloses wherein at least one of the steps of selecting at least one set of subcreatives, selecting a plurality of subsets of subcreatives, and assembling a plurality of aggregate creative forms is further executed according to scheduling criteria for transmission to users. (Paragraph 0093, 0094: Discloses a scheduling process for creating the advertisement and distributing the advertisement)

As per dependent claim 60, Evans et al discloses wherein at least one of the steps of selecting at least one set of subcreatives, selecting a plurality of subsets of subcreatives, and assembling a plurality of aggregate creative forms is further executed according to criteria for targeting transmission to specific users. (e.g. Paragraph 0093, 0094, 0095: Discloses scheduling criteria, user setup criteria)

As per dependent claim 61, Evans et al discloses the aggregate creative definition enables the step of assembling a plurality of aggregate creative forms to occur

even if a prescribed number of subcreatives is not available in one of the subsets of subcreatives. (Paragraph 0088, 0095)

As per dependent claim 62, Claim 62 recites similar limitations as in Claim 45 and is similarly rejection under rationale. Furthermore, Evans et al discloses the advertising system is configured to select aggregate creatives and non-aggregate creatives for transmission to users on the electronic network. (Paragraph 0063-0065, 0088, 0095: Template that contains the ad themes is selected to create the advertisement)

As per independent claim 63, Claim 63 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 66, Claim 66 recites similar limitations as in Claim 49 and is similarly rejected under rationale.

As per dependent claim 67, Claim 67 recites similar limitations as in Claim 50 and is similarly rejected under rationale.

As per dependent claim 68, Claim 68 recites similar limitations as in Claim 51 and is similarly rejected under rationale.

As per dependent claim 69, Claim 69 recites similar limitations as in Claim 52 and is similarly rejected under rationale.

As per dependent claim 70, Claim 70 recites similar limitations as in Claim 53 and is similarly rejected under rationale.

As per dependent claim 71, Claim 71 recites similar limitations as in Claim 54 and is similarly rejected under rationale.

As per dependent claim 72, Claim 72 recites similar limitations as in Claim 55 and is similarly rejected under rationale.

As per dependent claim 75, Claim 75 recites similar limitations as in Claim 58 and is similarly rejected under rationale.

As per dependent claim 76, Claim 76 recites similar limitations as in Claim 59 and is similarly rejected under rationale.

As per dependent claim 77, Claim 77 recites similar limitations as in Claim 60 and is similarly rejected under rationale.

As per dependent claim 78, Claim 78 recites similar limitations as in Claim 61 and is similarly rejected under rationale.

As per dependent claim 79, Claim 79 recites similar limitations as in Claim 62 and is similarly rejected under rationale.

As per independent claim 80, Claim 80 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 83, Claim 83 recites similar limitations as in Claim 49 and is similarly rejected under rationale.

As per dependent claim 84, Claim 84 recites similar limitations as in Claim 50 and is similarly rejected under rationale.

As per dependent claim 85, Claim 85 recites similar limitations as in Claim 51 and is similarly rejected under rationale.

As per dependent claim 86, Claim 86 recites similar limitations as in Claim 52 and is similarly rejected under rationale.

As per dependent claim 87, Claim 87 recites similar limitations as in Claim 53 and is similarly rejected under rationale.

As per dependent claim 88, Claim 88 recites similar limitations as in Claim 54 and is similarly rejected under rationale.

As per dependent claim 89, Claim 89 recites similar limitations as in Claim 55 and is similarly rejected under rationale.

As per dependent claim 92, Claim 92 recites similar limitations as in Claim 58 and is similarly rejected under rationale.

As per dependent claim 93, Claim 93 recites similar limitations as in Claim 59 and is similarly rejected under rationale.

As per dependent claim 94, Claim 94 recites similar limitations as in Claim 60 and is similarly rejected under rationale.

As per dependent claim 95, Claim 95 recites similar limitations as in Claim 61 and is similarly rejected under rationale.

As per dependent claim 96, Claim 96 recites similar limitations as in Claim 62 and is similarly rejected under rationale.

11. Claims 47-48, 56, 64-65, 73, 81-82, and 90 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evan et al (US PGPub 20020036654, published 3/28/2002) in further view of Yasnovsky et al (US PG Pub 20050027594, filed 11/3/2003, provisional application filed on 7/28/2003) in further view of Alao et al (US PGPub 20020147645, published 10/10/2002)

As per dependent claims 47-48, and 56, Evans and Yasnovsky et al fail to specifically disclose applying weighting criteria to the selected set of subcreatives in the at least one subcreative pool, wherein the plurality of subsets of subcreatives are selected according to the weighting criteria and wherein the aggregate creative definition includes one or more constraints for the step of selecting at least one set of subcreatives, the one or more constraints determining permitted combinations of subcreatives for the at least one set of subcreatives. Since each subset has at least one subcreative or just one, it has a combination of one. Therefore each subset has/is a subcreative. Thus, Alao et al discloses how advertisements are to be chosen based on constraints such as advertisement priority, advertisement weight, minimum advertisement display time, industry exclusions, overall frequency cap, minimum rotation interval, advertisement spec, advertisement type, and advertisement target. (Paragraph 0146, lines 15-21) Alao et al further details how ad-weighting works based on priority. (Paragraph 0146, lines 21-29) These constraints affect the level the priority thus changing the constraints producing a different list of order (combination) of display. Furthermore, when each advertisement item is edited or altered to include weight or constraints, it is considered generating a new or "copied" advertisement item with weight since it is different than the original unaltered advertisement.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified Evans et al and Yasnovsky et al with Alao et al's method since Alao et al's method would have provided a method for adaptive delivery of advertisements to a client.

Claims 64-65 recite similar limitations as in Claims 47-48 and are similarly rejected under rationale.

Claims 73 recite similar limitations as in Claim 56 and is similarly rejected under rationale.

Claims 81-82 recite similar limitations as in Claims 47-48 and are similarly rejected under rationale.

Claims 90 recite similar limitations as in Claim 56 and is similarly rejected under rationale.

12. Claims 57, 74, and 91 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evan et al (US PGPub 20020036654, published 3/28/2002) in further view of Yasnovsky et al (US PG Pub 20050027594, filed 11/3/2003, provisional application filed on 7/28/2003) in further view of Aphek (US PG Pub 20030191693, filed 4/8/2002)

As per dependent claim 57, Evans et al and Yasnovsky fail to specifically discloses wherein the step of assembling a plurality of aggregate creative forms occurs off-line from when the aggregate creative is selected for transmission. However, Aphek discloses the ability to create an advertisement off-line using the soft program for creating advertisements before transmitting the advertisement online to a Web server. (Abstract, Paragraph 0010-0011)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified Evan et al's and Yannovksy's method with

Aphek's method since Aphek's method would have provided the benefit of allowing advertisers to create and update graphical ads in an instant and independent manner without any delays and whenever desire.

As per dependent claim 74, Claim 74 recites similar limitations as in Claim 57 and is similarly rejected under rationale.

As per dependent claim 91, Claim 91 recites similar limitations as in Claim 57 and is similarly rejected under rationale.

#### ***Response to Arguments***

13. Applicant's arguments filed 23 October 2008 have been fully considered but they are not persuasive.

14. On pages 3-5, in regards to Applicant's argument of claims 63-96 rejected under 35 USC 101, Applicant argues the claims therefore comply with the statutory subject matter requirement since the claims are written in a means plus function format according to 35 USC 112, sixth paragraph as in Claims 63-79. Therefore, since the claims incorporated the means plus functions format properly, then the claims are within the statutory subject matter requirement of 35 USC 101. In addition, Applicant argues claims 80-96 that the storage device recited in the claims indicates hardware. However, the Examiner disagrees.

The Examiner respectfully submits that Claims 63-79 are properly written in the means plus function format and is supported by the specification; however, it does not necessarily mean that the claim complies with statutory subject matter requirement if the

claims comply with 35 USC 112, sixth paragraph. Claims 63-79 discloses a system for the automated generation and serving aggregate creative wherein the claims themselves, and the claim language as written fail to disclose any form of hardware indication. Claims 63-96 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 101. For claims 63-79, the claim language in the claims failed to disclose or mention what is included a system at all; thus, the claims are viewed as software in view of data structures. The use of the word "system" does not inherently mean that claim is directed to a physical machine. Claims 80-96 disclose a program product comprising a storage device containing instructions operable on a computer for the automated generation and serving of aggregate creatives wherein the claims themselves as written fail to disclose any form of hardware indication since the program product and the storage device are not viewed as physical structures. The storage device may be viewed as a physical structure according to the Applicant; however, the claim language itself does not indicate that the storage device is necessarily a physical structure since the descriptions of the storage device in the claim limitations do not disclose or suggest the unit are hardware or stored on any hardware at all and therefore are viewed as data structures and/or a system containing just software. The use of the word "program product" or "storage device" does not inherently mean that claim is directed to a physical machine.

Therefore, the claims, themselves, lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of

chemical compounds to be a composition of matter. As such, they fail to fall within a statutory. They are, at best, functional descriptive material *per se*. Thus, in regards to claims 63-96, the claims, as written, appear to be claiming "software systems" i.e. systems without hardware indication, which is computer program *per se*. The claims as written do not recite any hardware indication, therefore, viewed as "software systems".

15. In addition, applicant's arguments focus upon their belief that the affidavit filed 23 October 2008 overcome the Yasnovsky et al reference. However, as disclosed above, the affidavit fails to overcome the reference. Therefore, the related arguments are not persuasive.

### ***Conclusion***

10. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Faber/  
Examiner, Art Unit 2178  
/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178